UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,399	12/21/2001	Thomas Pfohe	30014200-1022	7396

58328 7590 01/12/2007

SONNENSCHEIN NATH & ROSENTHAL LLP
FOR SUN MICROSYSTEMS
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER	
GOLD, AVI M	
ART UNIT	**PAPER NUMBER**
2157	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/037,399	PFOHE ET AL.	
	Examiner	Art Unit	
	Avi Gold	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-11,13-20,22-25,27-29,31,32 and 34-37* is/are pending in the application.

4a) Of the above claim(s) __ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-11,13-20,22-25,27-29,31,32 and 34-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the amendment filed on December 4, 2006. Claims 9, 23, and 36 were amended. Claims 1-6, 8-11, 13-20, 22-25, 27-29, 31, 32, and 34-37 are pending.

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-6, 8-11, 13-20, 22-25, 27-29, 31, 32, 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Housel, III, U.S. Patent No. 6,535,869, further in view of Megiddo et al., U.S. Patent No. 6,957,224.

Housel teaches the invention substantially as claimed including a method, system, and computer-readable code for embedding a file index within a data file to which the index pertains (see abstract).

As to claims 1,15, and 35, Housel teaches a method, computer readable medium and a data processing system; in a data processing system for replacing data transmission request expressions, the method comprising the steps of:

receiving a data transmission request expression of a first type from a requestor, the data transmission request expression corresponding to data identified by a data transmission request expression of a second type (col. 8, lines 56-64, Housel discloses receiving a URL);

replacing the data transmission request expression of the first type with a replacement data transmission request expression of the second type (col. 8, lines 65-67, Housel discloses replacing the URL with a hashed record key);

retrieving the data using the replacement data transmission request expression; and sending the retrieved data to the requester (col. 8, lines 56-67, Housel discloses the retrieved data being sent).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches formatted data distributed on interconnected computers (see abstract). Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator

(URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Regarding claims 2 and 16, Housel teaches the method and computer readable medium of claims 1 and 15, further comprising the steps of:

determining whether the retrieved data comprises a data transmission request expression of the second type; and

when the retrieved data comprises a data transmission request expression of the second type, replacing the data transmission request expression in the retrieved data with a replacement data transmission request expression of the first type (col. 8, lines 56-67).

Regarding claims 3 and 17, Housel teaches the method and computer readable medium of claims 1 and 15, further comprising the steps of:

determining whether the retrieved data comprises an embedded data transmission request expression (col. 8, lines 56-64);

when the retrieved data comprises the embedded data transmission request expression, determining whether the data transmission request expression is supported by the requestor (col. 9, lines 1-10, Housel discloses choosing an appropriate hashing technique); and

when data transmission request expression in the retrieved data is not supported by the requestor, replacing the data transmission request expression in the retrieved data with a replacement data transmission request expression supported by the requestor (col. 9, lines 1-10).

Regarding claims 4 and 18, Housel teaches the method and computer readable medium of claims 1 and 15, further comprising the step of:

identifying the replacement data transmission request expression as an entry in a lookup table corresponding to the data transmission request expression of the first type (col. 18, lines 43-54, Housel discloses a hash table).

Regarding claims 5 and 19, Housel teaches the method and computer readable medium of claims 1 and 15, further comprising the steps of:

computing a hash value based on the data transmission request expression of the first type, and using the hash value to identify the replacement data transmission request expression as an entry in a lookup table corresponding to the data transmission request expression of the first type (col. 8, line 47 – col. 9, line 10).

Regarding claims 6 and 20, Housel teaches the method and computer readable medium of claims 1 and 15, further comprising the steps of:

determining whether the retrieved data comprises an embedded data transmission request expression;

when the retrieved data comprises the embedded data transmission request expression, determining whether a replacement data transmission request expression exists as an entry in a lookup table corresponding to the data transmission request expression in the retrieved data;

when no replacement data transmission request expression exists in the lookup table, generating a replacement data transmission request expression;

storing the generated replacement data transmission request expression in the lookup table in association with the data transmission request expression in the retrieved data (col. 8, line 47 – col. 9, line 10).

Regarding claims 8 and 22, Housel teaches the method and computer readable medium of claims 1 and 15, wherein the data is a web page (col. 8, lines 56-67).

Regarding claims 9, 23, and 36, Housel teaches a method, computer-readable medium, and data processing system; in a data processing system for replacing data transmission request expressions, the method comprising the steps of:

retrieving data including/having a data transmission request expression of a first type for sending to a requestor;

replacing the data transmission request expression in the retrieved data with a replacement data transmission request expression of a second type; and

sending the retrieved data with the replacement data transmission request expression to the requestor (col. 8, lines 56-67).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Regarding claims 10 and 24, Housel teaches the method and computer readable medium of claims 9 and 23, further comprising the steps of:

computing a hash value based on the data transmission request expression of the first type, and using the hash value to identify the replacement data transmission request expression as an entry in a lookup table corresponding to the data transmission request expression of the first type (col. 8, line 47 – col. 9, line 10).

Regarding claims 11 and 25, Housel teaches the method and computer readable medium of claims 9 and 23, further comprising the steps of:

determining whether a replacement data transmission request expression exists as an entry in a lookup table corresponding to the data transmission request expression in the retrieved data;

when no replacement data transmission request expression exists in the lookup table, generating a replacement data transmission request expression;

storing the generated replacement data transmission request expression in the lookup table in association with the data transmission request expression in the retrieved data (col. 8, line 47 – col. 9, line 10).

Regarding claims 13 and 27, Housel teaches the method and computer readable medium of claims 9 and 23, wherein the data is a web page (col. 8, lines 56-64).

Regarding claims 14 and 28, Housel teaches a method and computer readable medium; in a data processing system having a web server with a web page, the method comprising the steps performed by the web server of:

retrieving a web page using the replacement URL; and

sending the retrieved web page to the client (col. 8, line 47 – col. 9, line 10).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Regarding claims 29, Housel teaches a data processing system comprising:

a secondary storage device having a stored data identified by a data transmission request expression of a first type; a memory comprising a computer program that receives a data transmission request expression of a second type from a requestor, the data transmission request expression corresponding to data, replaces the data transmission request expression of the second type with a replacement data transmission request expression of the first type, retrieves the data using the replacement data transmission request expression, and sends the retrieved data to the requestor; and a processing unit that runs the computer program (col. 8, line 47 – col. 9, line 10).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the

replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Regarding claims 31, Housel teaches the data processing system of claim 29, wherein the data is a web page (col. 8, lines 56-64).

Regarding claims 32, Housel teaches a data processing system comprising:

a secondary storage device having a stored data having a data transmission request expression of a first type; a memory comprising a computer program that retrieves the data for sending to a requestor, replaces the data transmission request expression in the retrieved data with a replacement data transmission request expression of a second type, and sends the retrieved data with the replacement data transmission request expression to the requestor; and a processing unit that runs the computer program (col. 8, line 47 – col. 9, line 10).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Regarding claims 34, Housel teaches the data processing system of claim 32, wherein the data is a web page (col. 8, lines 56-64).

Regarding claims 37, Housel teaches a computer-readable memory device encoded with a data structure and a program that accesses the data structure, the program is by a processor in a system, the data structure having a plurality of entries, each entry comprising:

a data transmission request expression of a first type for retrieving a document identified by a data transmission request expression of a second type, wherein the

program replaces the data transmission request expression of the first type with a data transmission request expression of a second type before retrieving the document (col. 8, line 47 – col. 9, 10).

Housel fails to teach the limitation further including wherein the data transmission request expression is a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length.

However, Megiddo teaches the use of a shorthand URL associated with a registered URL (col. 2, lines 44-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Housel in view of Megiddo to use a first uniform resource locator (URL) having a first length and the replacement data transmission request expression is a second uniform resource locator (URL) having a second length. One would be motivated to do so because it is an efficient way of identifying and selecting web based information (col. 2, lines 31-32).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15, 23, 28, and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15, 23, 28, and 37 are not limited to tangible embodiment. In view of Applicant's disclosure, specification, page 8, lines 27-32, the medium is not limited to tangible embodiments (i.e. carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 16-20, 22, 24, 25, and 27 are necessarily rejected as being dependent upon the rejection of claims 15 and 23.

To expedite a complete examination of the instant application the claims (15-20, 22-25, 27, 28, and 37) rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Response to Arguments

4. Applicant's arguments filed December 4, 2006 have been fully considered but they are not persuasive.

Regarding the argument to claims 1, 9, 14, 15, 23, 28, 29, 32, and 35-37, the applicant argues that the reference, Housel, does not disclose replacing the data transmission request expression. The examiner respectfully disagrees, as seen in, col. 8, lines 65-67, there is a URL replaced with a hashed record key. Housel states that a different key, such as a hashed record key, may be used in replacement for a URL, which is the limitation of the claim.

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The use of a replacement is found in the Housel reference, not Megiddo.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,999,929 to Goodman

U.S. Pat. No. 5,751,961 to Smyk

U.S. Pat. No. 6,571,295 to Sidana

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

AMG